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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/089,806	08/13/2002	Josep Torrents I Comas	P/2789-58	3091
7590 06/09/2004				
Ostrolenk Faber Gerb & Soffen 1180 Avenue of the Americas New York, NY 10036-8403				
EXAMINER				
ASHLEY, BOYER DOLINGER				
ART UNIT		PAPER NUMBER		
3724		12		

DATE MAILED: 06/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/089,806

Applicant(s)

TORRENTS I COMAS, JOSEP

Examiner

Boyer D. Ashley

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 September 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3 and 4 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3 and 4 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. This office action is in response to applicant's amendment filed 9/5/03, wherein claims 1 and 2 were canceled; claims 3 and 4 were added.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 3-4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 3, the phrase "the handle" on line 12 is confusing, in that, it is not clear which handle is being referred to.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 3 and 4 are rejected under 35 U.S.C. 102(b) as being anticipated by ES 2,101,612, hereinafter ES '612.

ES '612 discloses the same invention as claimed including: a base (the support for ceramic 3); longitudinal guides (unlabeled but shown in Figure 1); a support movably mounted on the guides (1); a cutting wheel handle holder (33, see Figures 1 and 2, wherein the tool 2 is attached to shaft 30 which is attached to holder portion 33 that is

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shown as pivotal to the support); a cutting wheel handle (30) mounted in the handle holder; a cutting wheel (2) mounted on the handle; an actuating lever (6) mounted in a thread hole in the handle holder (see Figure 2) so as to immobilize the handle so that the handle applies pressure on a ceramic piece (3) to be cut by the cutting wheel. The cutting wheel handle (30) having an outer periphery with at least three longitudinally extending rebates (see 31/32 in Figure 5) and at least one longitudinally extending planar surface (34) for engaging the actuating lever (see page 2, lines 1-17 and page 3, lines 1-16).

It should be noted that the phrase "the rebates having a geometry so as to reduce a frequency of vibration during scoring of the ceramic piece by the cutting-wheel" is merely functional/intended use not defining any specific structure. ES '612 includes all of the same structure as claimed and is fully capable of the above-intended use.

As to claim 4, the cutting wheel handle holder of ES '612 forms a housing having a transverse section (see Figure 2) that corresponds to a transverse section of the cutting wheel handle, wherein the actuating lever, cutting wheel handle and cutting wheel handle holder form a hyperstatic fixing (the actuating lever 6 screws into the shaft handle 30 of the cutting wheel to force the cutting wheel handle/shaft against the cutting wheel handle holder, see Figure 1, 2, 3).

Response to Arguments

6. Applicant's arguments filed 9/5/03 have been fully considered but they are not persuasive.

Applicant contends the examiner uses Figure 5 of ES '612 as showing rebates but the applicant can find no description of the Figure 5 in the reference, which would discuss the purpose or construction of these rebates 32. Therefore, applicant contends that ES '612 lacks the at least three longitudinally extending rebates that have a geometry so as to reduce the frequency of vibration during scoring of the ceramic piece.

Although it is true that ES '612 lacks any description of Figure 5 the examiner respectfully disagrees with applicant that one of ordinary skill would not readily recognize the structure and purpose of the rebates in Figure 5 given the description of other embodiments. Moreover, it should be noted that figures in a patent whether they are described or not can be used to anticipate or make obvious claimed structures. There is no requirement for every figure to be described in order to use it in a rejection. Figure 5 of ES '612 is clearly just another embodiment like the pervious embodiments shown in Figures 2-4 as evident from the reference numerals and because they all appear to be describing similar elements. Clearly the rebates of Figure 5 function similarly to the rebates of Figures 2-4. See MPEP 2125. Furthermore, it should be noted that it is irrelevant whether or not the rebates of ES '612 have a "geometry so as to ... wheel" because this is merely intended use. What structure is claimed that is not in the ES '612?

Although, it appears applicant's has a translation of ES '612, the examiner is providing a copy of a recently acquired translation of ES '612 for applicant's review.

7. For the reasons above, the grounds of rejection are deemed proper.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Boyer D. Ashley whose telephone number is 703-308-1845. The examiner can normally be reached on Monday-Thursday 7:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan N. Shoap can be reached on 703-308-1082. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Boyer D. Ashley
Primary Examiner
Art Unit 3724

BDA
June 4, 2004